

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

At the outset, Applicants and Applicants' representative note with appreciation Examiner Klemanski's time and consideration in conducting a search and examination of the present application.

By the above amendments, claim 1 has been amended to recite a dye represented by formula (2), (3) or (4). Support for this amendment can be found in the instant specification at least at pages 4-6. Claims 2, 4 and 5 have been amended for readability purposes in a manner consistent with the above amendment to claim 1. Claim 8 has been amended to replace the word "using" with "utilizing".

In the Official Action, claim 8 stands rejected under 35 U.S.C. §112, second paragraph, for the reason set forth at page 2 of the Official Action. Without addressing the propriety of this rejection, it is noted that claim 8 has been amended to delete the objected-to word "using" and to recite "utilizing" in its place, in accordance with the Examiner's suggestion. Accordingly, withdrawal of the §112, second paragraph, rejection is respectfully requested.

Claims 1-11 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1, 6-11 and 15-17 of copending Application No. 11/184,992. Claims 1-11 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1, 4 and 5 in view of paragraphs [0039]-[0040], [0083]-[0084] and dyes g-1 through g-4 of the specification of copending Application No. 11/392,487.

Without addressing the propriety of the Examiner's comments in connection with the above obviousness-type double patenting rejections, and in an effort to expedite prosecution, submitted herewith is a Terminal Disclaimer over the '992 and '487 applications. Accordingly, withdrawal of the above obviousness double-patenting rejections is respectfully requested.

Claim 1 and 7-9 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,737,190 (*Shimada et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Shimada et al does not disclose each feature recited in claim 1, and as such fails to constitute an anticipation of such claim. As discussed above, claim 1 has been amended to recite a dye represented by formula (2), (3) or (4). *Shimada et al* does not disclose any of formulas (2), (3) or (4). In this regard, it is noted that the Patent Office has not rejected any of claims 2, 4 and 5 (which recite dyes represented by formulas (2), (3) or (4), respectively) in the present §102(b) rejection. Accordingly, for at least the above reasons, withdrawal of the rejection based on *Shimada et al* is respectfully requested.

Claims 1-3 and 7-11 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,878,196 (*Harada '196*). Claims 1-3 and 7-11 stand rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1, 2, 4-6, 8, 9, 11, 12 and 14 of *Harada '196*. Claims 1 and 4-11 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,923,855 (*Harada '855*). Claims 1-4 and 11 stand rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-9 of *Harada '855*. *Harada '196* and *Harada '855* are hereinafter referred to as the *Harada*

patents. Withdrawal of the above rejections is respectfully requested for at least the following reasons.

The *Harada* patents do not disclose or suggest each feature recited in independent claim 1. For example, the *Harada* patents do not disclose or suggest a dye represented by formula (2), (3) or (4) recited in claim 1. In this regard, it is noted that each of such formulas contains at least one -OM group at specific position(s). The *Harada* patents fail to disclose a compound which corresponds to formula (2), (3) or (4), in which the at least one -OM group is present at the specified position(s). The Patent Office has acknowledged this deficiency at pages 10-13 of the Official Action.

Concerning such subject matter, Applicants submit that by employing the claimed dye represented by formula (2), (3) or (4) having at least one -OM group at specific position(s), **surprising** and **unexpected** results can be attained, for example, in the form of improved ink stability. As discussed in the examples set forth in Applicants' disclosure, ink solutions were prepared employing inventive dyes 1 and 4 set forth at page 26 of the specification, and comparative dyes a and b set forth at page 51 of the specification. It is important to note that comparative dyes a and b did not have an -OM group at the specific position in the claimed formula (2). The resulting ink solutions were stored and evaluated in the manner discussed at page 50, and the results are set forth in Table 2. As can be seen from such table, concerning the ink stability characteristic, the ink solutions employing inventive dyes 1 and 4 exhibited a dye-remaining ratio of 95% or more ("A" rating). In stark contrast, the ink solutions employing comparative dyes a and b exhibited dye-remaining ratios of 85% to less than 95% ("B" rating), and less than 85% ("C" rating), respectively.

The *Harada* patents fail to have any recognition or suggestion of the significance of the presence of the -OM group at the specific position(s) indicated in the claimed

formulas. Thus, in light of such deficiencies, and in view of the surprising and unexpected nature of aspects of the claimed invention, it is apparent that claim 1 is non-obvious over the *Harada* patents. Accordingly, for at least the above reasons, withdrawal of the rejections is respectfully requested.

At pages 1 and 2 of the Official Action, the Patent Office has noted that a certified copy of JP 2004-030288 has not been received. The Notice of Acceptance of Application Under 35 U.S.C. § 371 and 37 C.F.R. § 1.495 mailed March 14, 2008, indicates that "Priority Documents filed on 03/23/2006" have been received by the Patent Office. Since it appears that copies of the priority documents were supplied by the International Bureau, Applicants respectfully request indication of receipt of all the priority documents in the next Office communication.

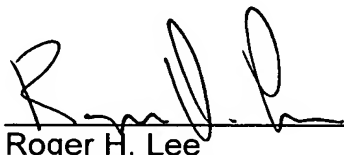
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By:



Roger H. Lee
Registration No. 46317

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620